REMARKS

Reconsideration of the rejections set forth in the Office action dated 10/13/2004 is respectfully requested.

The Claims

After entry of this amendment, claims 1 - 18 are pending in this application, of which claims 1, 3, 5 and 7 are independent claims. Claims 1 – 8 stand rejected.

Claims 1 – 8 have been amended. Support for the amendments to claim 1 is found in the specification from pages 6 to 8, and shown in Figure 2 in steps 210, 216 and 218. Amendments to independent claims 3, 5 and 7 are made to conform their language to the claim language of amended claim 1; support for these amendments is found in the specification as noted above for claim 1. Amendments to dependent claims 2, 4, 6 and 8 conform the language of these claims to their respective amended independent claims.

This amendment adds new claims 9 – 18 to original claims 1 – 8. Support for claim 9 is found in the specification from page 4, line 22 to page 5, line 2. Support for claims 10, 13 and 16 is found in the specification at page 5, lines 2 – 15. Support for claims 11, 14 and 17 is found in the specification at page 5, lines 20 - 22. Support for claims 12, 15 and 18 is found in the specification generally at pages 6 - 8.

I. 35 USC § 102(b)

Claims 1, 3, and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Unger (US 5,721,910). The requirements for a *prima facie* case of anticipation under 35 U.S.C. § 102 have been made in previous Replies filed on 8/6/03, 2/4/04 and 7/19/04 in this application; those requirements are incorporated by reference herein from those Replies. In particular, the Examiner's attention is directed to the Federal Circuit's comment in C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1349, 48 USPQ2d 1225, 1229-30 (Fed. Cir. 1998): "[w]hen the defense of lack of novelty is based on a printed publication that is asserted to describe the same invention, a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device." It is respectfully submitted that the Unger reference does not teach

each and every claim limitation of currently amended claims 1, 3 and 5 as arranged in those claims, and therefore cannot anticipate these claims. Independent claim 3, directed to a computer system and independent claim 5, directed to a computer program have limitations and meaning similar to claim 1. Thus, the discussion below, while referring to independent claim 1, applies equally to independent claims 3 and 5.

The basic teachings of the Unger reference.

The Office Action recites, and Applicant agrees, that Unger teaches the element of "determining the document category of the loaded document" at col. 3, lines 9 – 15. This passage states:

> This database disaggregates a set of patents and/or technical documents into discrete technical categories by use of a set of pre-defined search protocols which match the scientific or technical concepts within the model. The pre-determined search strategies automatically categorize the set of technical documents to fit the multidimensional hierarchical model of a scientific or business discipline.

The set of pre-defined search protocols or strategies are later referred to as "expert technical searches (ETS)" each of which "is created to identify patents or technical documents that are pertinent to each individual category within the Customized Technical Search Hierarchy." Col. 5, lines 52 – 59. The invention disclosed in the Unger reference starts with a hierarchical model of a complex business, scientific or technical entity or specialty (col. 2, lines 58 – 60). Technical documents, such as patents or scientific or technical publications, or abstracts of those patents or publications, are assigned to one or more categories within the hierarchical model (col. 2, lines 61 – 65) using the set of ETS to categorize each document.

As clearly illustrated in the examples described in cols. 7 – 8, a user of the database disclosed in Unger first creates a model of categories and then searches to find documents to fit the categories. The expert technical and/or scientific searches (ETS) use all the expertise of a skilled technical searcher and capture that expertise in a set of pre-defined search strategies. Col. 7, lines 25 – 27. Then the searches are applied to a set of technical documents to populate the database. See col. 7, lines 52 – 67 and the text of claim 8 at col. 13.

Once the database has been populated with documents that fit the model (i.e., match the search criteria of the ETS, see col. 6, lines 5 – 9), graphical and tabular displays of the data and further mathematical analysis of the data may take place. See, for example, the examples at cols. 9 – 10. Unger states that "[t]he present database includes a multidimensional hierarchy of subject categories wherein the different levels of the hierarchy are interrelated by a mathematical formula." Col. 10, lines 49 – 51. Thus, it would appear that once the database is populated with the documents relevant to the model, the remaining processing involves accessing the documents to provide the analysis and presentation of the data.

This conclusion is further supported by Figure 1 and its accompanying description, where it is noted that the pre-processing of the set of technical documents takes place in Stages I and II, while stages III and IV represent the database design of Unger's invention. (Figure 1 and Col. 5, lines 3 – 50.) Moreover, Stage III represents the electronic capture of patent abstracts and/or technical documents and the parsing of the complex, multi-entity data fields which usually accompany these documents, (col. 5, lines 17 – 20) and is also clearly a pre-processing step relative to Stage IV, which represents the design of the hierarchical model. (Col. 5, lines 36 – 40.) Prior to Stage IV, no categories or models exist, documents have not yet been categorized and the database has not yet been populated.

The Unger reference does not teach the requisite extracting information step.

The Office Action recites that Unger teaches extracting information from said loaded document at col. 1, lines 21-24, col. 7, lines 26-46 and col. 10, lines 34-37. This discussion will evaluate these teachings against the revised claim language of claim 1 which requires extracting information from said loaded document indicating at least one of a document date, a document transaction type and a document identifier. The cited passages in Unger variously refer to extracting meaning from documents, applying the expert technical searches to find and categorize the documents to populate the database, and deriving abstract concepts from the documents by applying mathematical methods. The reference to the passage in column 1 actually is preceded by the phrase "the prior art does not disclose a database system that can..." which appears to negate the teaching the

passage is cited for. The passage cited at col. 7 refers to the ETS which has already been discussed above as being used to categorize the documents, not extract information from them. The passage at col. 10 may indirectly imply that certain information from the documents is extracted to derive the abstract concepts, but none of these passages refer to information indicating at least one of a document date, a document transaction type and a document identifier.

The Unger reference does not teach the requisite document handling procedure.

The Office Action recites that Unger teaches receiving at least one processing rule wherein the rule is associated with the document category at col. 3, lines 22-28, col. 4, lines 44-57 and col. 7, lines 40-46. This discussion will evaluate these teachings against the revised claim language of claim 1.

Amended claim 1 of the subject invention requires applying to the loaded document at least one document handling procedure associated with the document category of said loaded document. The step of applying the document handling procedure is distinct from, and follows, the step of determining the document category and requires that the document category be known since the document handling procedure applied to the loaded document is one associated with the document category of the loaded document. Amended claim 1 further requires that the document handling procedure link said loaded document to at least one of said plurality of stored documents using the at least one of the document date, the document transaction type and the document identifier extracted from said loaded document.

As noted above in the discussion of the teachings of the Unger reference, once the database is loaded with the technical documents, subsequent processing involves analysis of the data in order to identify trends and discontinuities in the research efforts represented by the technology in the underlying technical documents. It is respectfully submitted that the passages in Unger which discuss the analysis features of the invention do not teach any further linking of one document to another in the database.

Unger discloses at col. 3, lines 22-28 that the categorization of the documents may then be used by the relational database to identify trends and discontinuities in the

research efforts represented by the technology in the underlying technical documents, and may be further used to examine the underlying documents which constitute these trends and discontinuities. Unger discloses similar subject matter at col. 7, lines 40-46, referring to the ability to apply mathematical relationships against the matrix of technical categories. It is respectfully submitted that neither the verbs "identify" nor "examine" in these passages teach the document handling procedure linking said loaded document to at least one of said plurality of stored documents using the at least one of the document date, the document transaction type and the document identifier extracted from said loaded document.

The passage in Unger at col. 4, lines 44-57 suggests that scientists may evaluate information from the technical documents that have been categorized to capture essential details of each invention into subject-specific tables which can be linked back to the original documents and to the original classification. This appears to be a human step, not a computer-implemented step. The actually method for the linking is not discussed; it would be reasonable to conclude, since the automatic (computer-implemented) classification of the documents has already been done, that the linking is done manually by the scientist. In any event, there is no mention of linking said loaded document to at least one of said plurality of stored documents using the at least one of the document date, the document transaction type and the document identifier extracted from said loaded document.

The Office Action further recites col. 7, lines 26 – 51 and col. 10, lines 34 – 65 as teaching subject matter relevant to the processing rule. Unger describes the expert technical searches at col. 7, lines 26 - 51. As noted above, the expert searches are applied to a collection of technical documents to create the database. This passage, then, does not teach a document handling procedure associated with a document category, since the database has not yet been populated and the documents do not yet have categories: The passage at col. 10, lines 34 – 65 is directed to the method of deriving more abstract concepts from the set of stored category assignments by applying mathematical methods to extract the concepts. This passage talks about the analysis functions of the database invention disclosed in Unger. It mentions counts of unique items in categories and

multiplying by weighting factors. At this point, it would be reasonable to assume that processing associated with linking one document to other documents has been completed, in order for this analysis phase to take place. There is no reference in this passage to applying to the loaded document at least one document handling procedure associated with the document category of said loaded document. There is also no reference in this passage to the document handling procedure linking said loaded document to at least one of said plurality of stored documents using the at least one of the document date, the document transaction type and the document identifier extracted from said loaded document.

It is respectfully submitted that Unger does not teach each and every claim limitation of currently amended claims 1, 3, and 5, as arranged in those claims. For the foregoing reasons, it is respectfully submitted that the Office Action fails to make a *prima facie* case of anticipation against independent claims 1, 3 and 5, and it is respectfully requested that the rejections of these claims be withdrawn.

II. Rejections under 35 USC §103

Claim 7 stands rejected under 35 USC §103(a) as being unpatentable over Unger. Claim 7 claims a method for transferring a computer program product from one or more first computers to a second computer connected to the one or more first computers through a communications medium. The Office Action further takes Official Notice, in paragraph 9, that both the concept and advantage of transferring computer-executable instruction from one computer to another is well known and expected in the art. The Office Action concludes that "it would have been obvious to one of ordinary skill in the art at the time the inventions was made to allow users to transfer the computer-executable instruction contained in Unger's system from one computer to another through a communication medium for sharing purposes." (OA at page 5.)

The limitations of the computer program product set forth in claim 7 are similar to those of the computer program product of claim 5. The arguments above made with respect to inapplicability of the Unger reference to independent claim 5 apply equally to claim 7: Unger does not teach each and every claim limitation of currently amended claim 7, as arranged in that claim, and the Office Action fails to make a *prima facie* case

of anticipation against independent claim 7. For the foregoing reasons, therefore, is believed that independent claim 7 is not obvious in view of the Unger disclosure and the practice in the art of transferring files between computer systems, and is also believed to be in condition for allowance.

III. Rejections under 35 USC §103

Claims 2, 4, 6, and 8 are rejected under 35 USC 103(a) as being unpatentable over Unger for the same reasons cited in the §102 argument and further in view of MacPhail, US 5,107,419. MacPhail is cited for teaching that the processing rule includes retention criteria for determining how long to save a document. The Office Action states, as motivation for the combination of Unger and MacPhail, that "MacPhail's teaching of using retention criteria to determine whether the documents in the document storage exceeds expiration date can help the processing rule in Unger's system to automatically delete documents that are no longer needed to save system storing space."

First, since claims 2, 4, 6, and 8 depend on and further limit claims 1, 3, 5, and 7, these dependent claims are patentable for the same reasons cited above for the patentability of claims 1, 3, 5 and 7 over the Unger reference.

Moreover, claims 2, 4, 6, and 8 are also patentable over the combination of Unger and MacPhail because Unger appears to teach away from establishing any sort of retention scheme for the records in the technical database. See for example col. 6, lines 24 – 33 where Unger states:

> The database system allows patents and/or technical documents to be electronically captured and analyzed at a convenient time. This set of analyzed patents and/or technical documents may then be used to identify trends and discontinuities in the overall pattern of research efforts represented by the set of patents or technical documents. These trends and discontinuities may be identified any time following the analysis of the set of patents and/or technical documents. The stored analysis may be used minutes, days, months or years later.

As already noted above, the database records in the Unger database are specifically included and categorized for the purpose of building a multidimensional hierarchical model which reflects the business, scientific or technical interests of a

business, scientific or technical entity or specialty. (Abstract). "In order to create a computer system which can answer higher level questions such as these, the computer system must have a pre-defined model of the overall scientific or business discipline and the computer system must have already analyzed the technical content of each patent or technical document with respect to that model." (Col. 4, lines 32 – 37.). Unger clearly suggests that these documents are included or not included in the database based on the initial model, and not based on some retention scheme. If the analysis that can be generated can be used "minutes later" or "years later," then clearly it is the model that controls retention of the individual technical documents in the database.

MacPhail teaches a method for managing the automatic retention and deletion of a relatively large number of documents that are stored in the system by a plurality of end users. (Abstract). The method establishes a dual label for each document that is to be stored in the system. The first label is the Document Label (DL) and functions to identify the business use classification of the document. The second label is the Ownership Label (OL) and functions to identify a document classification assigned by the owner which in most situations is the author. See col. 3, lines 10 – 16. Ownership implies the authority and responsibility for the document during the ownership period. Col. 3, lines 21 – 23. Each document filed in the system has associated with it the label and expiration date criteria that are employed to automatically manage the retention and deletion of documents from the system. Col. 3, lines 26 – 29. There are also system default expiration dates that are entered for documents when no dates are entered by a user who processes a document. See col. 3, lines 44 – 58.

It is respectfully submitted that the database of documents in Unger is not suitable for the retention method disclosed in MacPhail. As noted above, the categories defined in the model seems to control which documents are included or retained in the database. Moreover, if there are several users of the Unger database, it would seem unreasonable to allow any one user control over when to delete a document, since deleting a document from a category will affect the accuracy of the analysis of technical trends and discontinuities for that category for other users of the database.

For the foregoing reasons, it is respectfully submitted that a person of ordinary skill in the art would not look to the MacPhail reference to develop a retention scheme for the technical documents in the database taught in Unger. The motivation to make the combination cited in the Office Action is simply not reasonable.

For the foregoing reasons, claims 2, 4, 6, and 8 are patentable over the combination of the teachings in Unger and MacPhail, and are therefore in condition for allowance.

IV. Patentability of New Claims 9 - 18

Claim 9 recites that the loaded document further includes document format data specifying whether the loaded document is an electronic document or a document image. Unger discloses that the database of technical documents may include document images (see Unger, col. 4, lines 1 – 7) but does not appear to disclose that the technical documents being categorized for the database include document format data specifying whether the loaded document is an electronic document or a document image.

Claims 10, 13 and 16 recite that the document category of the loaded document is determined by data content extracted from the loaded document and matched to a pre-determined set of document categories, while claims 11, 14 and 17 recite that the document category is determined by a pre-determined category input with the loaded document. The Unger disclosure does not seem to teach that the technical documents may be added to the database based on a pre-determined category input with the technical document; in Unger, the technical documents that qualify for the database are determined using a set of pre-defined search protocols (the ETS) which match the scientific or technical concepts within the model. (Unger, col. 3, lines 9 – 15.) .

Claims 12, 15 and 18 recite that the information extracted from the loaded document is a document identifier indicating an account number and a transaction date. Claims 12, 15 and 18 further recite that the document handling procedure links the loaded document to a set of stored documents having the account number, and orders the loaded document among the set of stored documents by the transaction date. The Unger disclosure teaches the use of scientific or technical documents and appears to make no

mention of extracting an account number from the technical documents using the expert technical searches. As noted above, Unger teaches the linking of the documents to the categorization which reflects the overall hierarchical model (Unger, col. 3, lines 46 – 49) but does not appear to teach linking a technical document to other stored technical documents by account number.

For the foregoing reasons, claims 9 - 18 are also patentable over the Unger reference, and are therefore in condition for allowance.

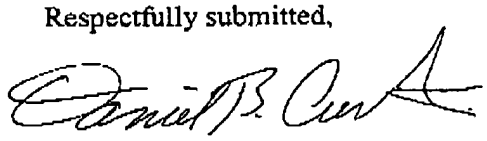
V. Reconsideration Requested

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered or traversed and shown to be inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 CFR §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation authorized attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

Should any additional issues remain, or if I can be of any additional assistance, please do not hesitate to contact me at (650) 812-4259.

Respectfully submitted,



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